

*Please add the following claims:*

*! 3*  
50. (New) An agricultural composition as claimed in claim 1, further comprising at least one compatible fungicidal agent.

51. (New) A composition of claim 1, diluted with water to a concentration below a threshold in which there is significant herbicidal action, wherein the diluted composition is for use as a fungicide.

#### REMARKS

Claims 17 and 21 have been amended and claims 50 and 51 added in order to more clearly claim the invention. No new matter is added herewith. Changes to the claims can be seen on a separate page entitled VERSION WITH MARKINGS TO SHOW CHANGES MADE following the signature page. Deletions are in **[bold and brackets]** and insertions are underlined.

#### Claim Rejection Under 35 U.S.C. § 112

Claims 17 and 21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended the claims to more clearly set forth the scope of the claims. Claims 50 and 51 have been added to further clarify the matter. Applicants respectfully request withdrawal of the rejection on this basis, in light of the amendments.

#### Claim Rejection Under 35 U.S.C. § 102

Claims 1 and 2 were rejected under 35 U.S.C. § 102 (a), (b), and (e) as being anticipated by Barranx et al. Applicants again assert that the composition of Barranx is not the same as the presently claimed invention. Barranx does not disclose or enable a composition comprising sufficient fatty acid soap and/or sufficient foam enhancing agent to allow the composition to be applied as, or to produce, a foam having at least a surface monolayer of bubbles during use. When a reference is silent as to a characteristic which is asserted to be inherent, that characteristic must be *necessarily contained in the reference* and such presence would be appreciated by one of ordinary skill in the art. Continental Can Co. USA, Inc. v. Monsanto Co., 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Furthermore, “[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.” In re Rijckaert, 28 U.S.P.Q.2d 1955 (Fed.

Cir. 1993) “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” (*In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981) (emphasis in original), *quoting Hansgirg v. Kemmer*, 102 F.2d 212, 214 (C.C.P.A. 1939).) Therefore, inherency is not a matter of hindsight, in that the missing element must have been precisely discernable from the reference as being a necessary result of what is disclosed, not just one of the possibilities. In the present case, it does not necessarily follow from what is disclosed in the cited references that the composition of Barranx would form a foam having at least a surface monolayer of bubbles as is recited in the present claims. Therefore, it is submitted that the cited reference does not anticipate the claims on the basis of inherency, and Applicants respectfully request withdrawal of the rejection on this basis.

Claim Rejection Under 35 U.S.C. § 103

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19, 21-25, 28-29, and 47-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Barranx and Richter. The combination of Barranx and Richter does not teach a composition as recited in the present invention. The presently claimed invention is capable of forming at least a monolayer of bubbles, as recited in the claims, without the use of an optional foaming agent. Furthermore, no additional foaming agents are used to increase the stability of the foam or bubbles. The presently claimed invention provides the beneficial characteristic of being able to form at least a monolayer of bubbles, a characteristic which is not taught or suggested by the prior art. Applicants respectfully request withdrawal of the rejection on this basis.

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, and 47-49 were rejected as being unpatentable over the combined teachings of Pullen et al. and Evans et al. Applicants assert that no suggestion is provided by either Pullen or Evans to the presently claimed invention, which is capable forming at least a monolayer of bubbles. Applicants assert that this property is not an inherent or expected characteristic of the prior art. Applicants respectfully request withdrawal of the rejection on this basis.

Conclusion

In light of the foregoing amendments and remarks, Applicants respectfully request withdrawal of the Examiner's rejections. Should any issues arise which may delay prosecution of the present application the Examiner is respectfully invited to contact the under-signed agent at the telephone number below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Dec. 4, 2002

By:

Catherine M. Sanders

Catherine M. Sanders  
Registration No. 50,660  
Agent of Record  
620 Newport Center Drive, Sixteenth Floor  
Newport Beach, CA 92660  
(949) 721-6357



VERSION WITH MARKINGS TO SHOW CHANGES MADE

Deletions are in [bold and brackets] and insertions are underlined.

**IN THE CLAIMS:**

**Please amend the following claims:**

17. (Twice Amended) An agricultural composition as claimed in claim 1, further comprising at least one component selected from the group consisting of surfactants, foaming agents, emulsifiers, pesticides, [ compatible fungicidal agents,] and fertilizing components.

21. (Twice Amended) A composition of claim 1, diluted with water to a concentration below a thresh-hold in which there is significant herbicidal action, wherein the diluted composition is for use as a pesticide[ or fungicide].

**Please add the following claims:**

50. (New) An agricultural composition as claimed in claim 1, further comprising at least one compatible fungicidal agent.

51. (New) A composition of claim 1, diluted with water to a concentration below a threshold in which there is significant herbicidal action, wherein the diluted composition is for use as a fungicide.

H:\DOCS\CMS\CMS-3373.DOC  
120402

RECEIVED  
DEC 12 2002  
TECH CENTER 1600/2900